2873.

# SUPREME COURT OF THE UNITED STATES.

## No. 213.

THE MASSACHUSETTS ARMS COMPANY, PLAINTIFF IN ERROR,

vs.

SAMUEL COLT.

IN ERROR TO THE CIRCUIT COURT, UNITED STATES, FOR THE DISTRICT OF MASSACHUSETTS.

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[GIDEON, Print.]

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UNITED STATES, *ss.*

The President of the United States, to the judges of the circuit court holden in and for the district of Massachusetts, greeting :
[L. S.]

Because that, in the record and process, and also in the rendering of judgment in a suit before you, or some of you, between Samuel Colt, of Hartford, in the district of Connecticut, manufacturer of fire arms, plaintiff, and the Massachusetts Arms Company, a corporation duly incorporated by law and doing business in the town of Chickopee, in our district of Massachusetts, defendants, in a plea of the case a manifest error has intervened to the great damage of the said Massachusetts Arms Company, as in their complaint has been stated. And as it is just and proper that the error, if any there be, should be corrected in due manner, and that full and speedy justice should be done to the parties aforesaid in this behalf, you are hereby commanded, that, if judgment thereof be given, then under your seal you do distinctly and openly send the record and process in the suit aforesaid, with all things concerning them, and this writ, so that you have the same before the chief justice and the associate justices of the Supreme Court of the United States, on the first Monday of December next, at Washington, being the present seat of the national Government, that the record and process aforesaid being inspected, they may cause to be done thereupon what of right ought to be done.

Witness the honorable Roger B. Taney, esquire, chief justice of the said Supreme Court, at Washington aforesaid, this fourteenth day of November, in the year of our Lord one thousand eight hundred and fifty-one, and of the independence of the United States the seventy-sixth.

ISAAC O. BARNES, *Clerk.*

Allowed by

P. SPRAGUE.

UNITED STATES OF AMERICA,
*Massachusetts district.*

October term, 1851.

At a circuit court of the United States, begun and holden at Boston, for the first circuit and district of Massachusetts, on Wednesday, the fifteenth day of October, in the year of our Lord one thousand eight hundred and fifty-one, before the honorable Benjamin R. Curtis, associate justice, and honorable Peleg Sprague, district judge.

[REC. CCXIII, D. T. 1851.]—1

SAMUEL COLT, of Hartford, in the district of Connecticut, manufacturer of fire arms, plaintiff,
vs.
The Massachusetts Arms Company, a corporation duly incorporated by law, and doing business in the town of Chickopee, in our district of Massachusetts, defendants.

In a plea of the case, for that heretofore, to wit. on the twenty-fourth day of October, in the year eighteen hundred and forty-eight, letters patent, bearing date on the day and year last aforesaid, signed by James Buchanan, secretary of state, and countersigned by Edmund Burke, commissioner of patents, and bearing the seal of the patent office of the United States, were duly issued, reciting that whereas Samuel Colt, of Hartford, Connecticut, had alleged that he had invented a new and useful "improvement in fire arms," (for which letters patent, dated February 25th, 1836, were granted to him, which letters were cancelled on account of a defective specification,) which he stated had not been known or used before his application; had made oath that he was a citizen of the United States; that he verily believed that he was the original and first inventor or discoverer of the said improvement, and that the same had not, to the best of his knowledge and belief been previously known or used; had paid into the treasury of the United States the sum of fifteen dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent might be granted for that purpose.

And thereupon there was granted by said letters patent, according to law, to the said Samuel Colt, his heirs, administrators, or assigns, for the term of fourteen years, from the twenty-fifth day of February, eighteen hundred and thirty-six, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Samuel Colt, in the schedule annexed to said letters patent, and is made a part thereof; all which said recitals in the said letters patent contained the plaintiff avers to be true.

And the plaintiff further avers, that afterwards, the said Samuel Colt having made application, in due form of law, unto the Commissioner of Patents, for an extension of the aforesaid patent, such proceedings were had, under and in conformity with the statute of the United States, in such case made and provided, that, on the tenth day of March, in the year eighteen hundred and forty-nine, the said patent was extended for the term of seven years, from and after the twenty-fifth day of February, in the year eighteen hundred and fifty; all of which, by reference to the certificate of extension, or a duly certified copy thereof, will more fully appear.

And the plaintiff further avers, that afterwards, to wit, on the first day of March, in the year eighteen hundred and fifty, and on sundry

days and times before and afterwards, during the said term of seven years aforesaid, and before the purchase of this writ, the said defendants well knowing the premises, to wit, at Boston, in the district of Massachusetts, did make, use, and vend to others, divers, to wit, three hundred of the said patented articles, in violation and infringement of the exclusive right so secured to the plaintiff by said letters patent as aforesaid, and contrary to the form of the statute of the United States in such case made and provided; whereby the plaintiff has been greatly injured, and deprived of great profits and advantages which he might, and otherwise would, have derived from said invention, and has sustained actual damage to the amount of three thousand dollars; and, by force of the statute aforesaid, an action has accrued to him to recover the said actual damages, and such additional amount, not exceeding in the whole three times the amount of such actual damages, as the court may see fit to order and adjudge.

Yet the said defendants, though requested, have never paid the same, or any part thereof, to the plaintiff; but have refused, and still do refuse, so to do.

2d count. And also for that, heretofore, to wit, on the twenty-ninth day of August, in the year eighteen hundred and thirty-nine, letters patent, bearing date the day and year last aforesaid, signed by A. Vail, acting secretary of state, and countersigned by Henry L. Ellsworth, commissioner of patents, and bearing the seal of the Patent office, were duly issued, reciting that Samuel Colt, of Paterson, New Jersey, had alleged that he had invented a "new and useful improvement in fire arms and in the apparatus used therewith," which he stated had not been known or used before his application; had made oath that he was a citizen of the United States; that he verily believed that he was the original and first inventor or discoverer of the said improvement, and that the same had not, to the best of his knowledge and belief, been previously known or used; had paid into the Treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent might [be] granted for that purpose. And thereupon there was granted by said letters patent, according to law, to the said Samuel Colt, his heirs, administrators, and assigns, for the term of fourteen years from the twenty-ninth day of August, in the year eighteen hundred and thirty-nine, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Samuel Colt in the schedule to said letters patent annexed, and is made a part thereof; all which said recitals in the said letters patent the plaintiff avers to be true.

And the plaintiff further avers, that afterwards, to wit, on the first day of March, in the year eighteen hundred and fifty, and on sundry days and times before and afterwards, during the said term of fourteen years mentioned in the said letters patent, and before the purchase of this writ, the said defendants, well knowing the premises, to wit, at

Boston, in the district of Massachusetts, did make, use, and vend to others to be used, divers, viz., three hundred of the said patented articles, in violation and infringement of the exclusive right so secured to the plaintiff by said letters patent as aforesaid, and contrary to the form of the statute of the United States in such case made and provided; whereby the plaintiff has been greatly injured, and deprived of great profits and advantages which he might, and otherwise would, have derived from his said invention, and has sustained actual damages to the amount of three thousand dollars; and, by the force of the statute aforesaid, an action has accrued to him to recover the said actual damages, and such additional amount, not exceeding in the whole three times the amount of such actual damages as the court may see fit to order and adjudge. Yet the defendants, though often requested, have never paid the same, nor any part thereof, to the plaintiff; but have refused, and still do refuse, so to do.

3d count. And also for that, that heretofore, to wit, on the twenty-fourth day of October, in the year eighteen hundred and forty-eight, letters patent, bearing date on the day and year last aforesaid, signed by James Buchanan, secretary of state, and countersigned by Edmund Burke, commissioner of patents, and bearing the seal of the Patent office of the United States, were duly issued, reciting that whereas Samuel Colt, of Hartford, Connecticut, had alleged that he had invented a new and useful "improvement in fire arms," (for which letters patent, dated February 25th, 1836, were granted to him, which letters were cancelled on account of a defective specification,) which he stated had not been known or used before his application; had made oath that he was a citizen of the United States; that he verily believed that he was the first and original inventor or discoverer of the said improvement, and that the same had not, to the best of his knowledge and belief, been previously known or used; had paid into the Treasury of the United States the sum of fifteen dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent might be granted for that purpose; and thereupon there was granted by said letters patents, according to law, to the said Samuel Colt, his heirs, administrators, or assigns, for the term of fourteen years from the said twenty-fifth day of February, eighteen hundred and -six, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Samuel Colt, in the schedule annexed to the said letters patent, and is made a part thereof; all which said recitals in the said letters patent the plaintiff avers to be true.

And the plaintiff further avers, that afterwards, the said Samuel Colt having made application in due form of law unto the Commissioner of Patents for an extension of the aforesaid patent, such proceedings were had under and in conformity with the statute of the United States, in such case made and provided, that on the tenth day of March, in the year eighteen hundred and forty-nine, the said patent was extended for

the term of seven years, from and after the twenty-fifth day of February, in the year eighteen hundred and fifty; all of which, by reference to the certificate of extension, or a duly certified copy thereof, will more fully appear.

And the plaintiff further avers, that heretofore, to wit, on the twenty-ninth day of August, in the year eighteen hundred and thirty-nine, letters patent bearing date the day and year last aforesaid, signed by A. Vail, acting secretary of state, and countersigned by Henry L. Ellsworth, commissioner of patents, and bearing the seal of the Patent office, were duly issued, reciting that whereas Samuel Colt, of Paterson, New Jersey, had alleged that he had invented a new and useful "improvement in fire arms and in the apparatus used therewith," which he stated had not been known or used before his application; had made oath that he verily believed himself the original and first inventor or discoverer of the said improvement, and that the same had not, to the best of his knowledge and belief, been previously known or used; had paid into the Treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent might be granted for that purpose; and thereupon there was granted by said letters patent, according to law, to the said Samuel Colt, his heirs, administrators, and assigns, for the term of fourteen years, from the twenty-ninth day of August, in the year eighteen hundred and thirty-nine, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Samuel Colt, in the schedule to said letters patent annexed, and is made a part thereof; all which said recitals in the said letters patent the plaintiff avers to be true.

And the plaintiff further avers, that afterwards, to wit, on the first day of March, in the year eighteen hundred and fifty, and on sundry days and times before and afterwards, during the said term of fourteen years mentioned in said letters patent, and also during the said extended term of seven years, and before the purchase of this writ, the said defendants, well knowing the premises, to wit, at Boston aforesaid, did make, use, and vend to others to be used, divers, viz., three hundred of the said patented articles, in violation and infringement of the exclusive rights so secured to the plaintiff by said letters patent as aforesaid, and contrary to the form of the statute of the United States in such case made and provided, whereby the plaintiff has been greatly injured and deprived of great profits and advantages which he might and otherwise would have derived from his said inventions, and has sustained actual damage to the amount of three thousand dollars; and by force of the statute aforesaid an action has accrued to him to recover the said actual damages, and such additional amount, not exceeding in the whole three times the amount of such actual damages as the court may see fit to order and adjudge.

Yet the said defendants, though often requested, have never paid

the same nor any part thereof to the plaintiff, but have refused and still do refuse so to do.

This action was entered at the October term, A. D. 1850, of this court, when and where the parties appeared by their respective attorneys, and thence was continued to the May term, A. D. 1851; and now the said defendants come and defend, and say they are not guilty in manner and form as the plaintiff in his declaration has alleged; and of this they put themselves upon the country.

By their attorney,

R. A. CHAPMAN.

And the plaintiff doth the like, by his attorney,

GEO. T. CURTIS.

And the defendants filed the following notices, viz:

And in addition to all matters proper to be given in evidence upon the general issue, the defendants will offer in evidence the following special matter, to wit:

That the said Colt was not the original or first inventor of the improvements in fire arms, mentioned in his declaration and the letters patent therein referred to, nor of the several substantial and material parts thereof; that the same have been described in the several public works hereafter referred to, and the authorities quoted by them, anterior to the supposed discovery thereof by said Colt; and the defendants state the names of the following persons who had a prior knowledge of said improvements, with their places of residence, and the places where the said improvements had been used, viz., David Bentley, of Birmingham, England, place where used, Birmingham; John Fisher, of New York city, saw it used at New Orleans and London, England; John Cooper, New York, saw it used at New York; Joseph Cooper, New York, saw it used at New York; Henry H. Bishop, Boston, Massachusetts, Boston; Thomas Bargery, Boston, Massachusetts, Boston; David G. Colburn, Hoosick falls, New York, saw it used at Van Buren, Canandaigua, Port Byron, Auburn, Syracuse, Buffalo, Pen Yan, Geneva, State of New York, Washington, D. C.; Montrose, Susquehanna county, Pa.; Fairfax, county, Va.; see also the letters patent granted to said Colburn, June 29, 1833; Nichols & Childs; Richard Davidson, of Boston, saw it [at] Boston and Birmingham. England; Walter Olmstead, Montrose, Pa., Montrose; Sidney H. Warren, Montrose, Pa., Montrose; De Witt C. Warren, Montrose, Pa., Montrose; John Child, Springfield, Massachusetts, Washington, D. C.; John Shattuck, Jefferson county, Ohio, Jefferson county and Cincinnati, Ohio; Larkin M. Leland, Worcester, Massachusetts, Augusta, Georgia; Edwin H. Prescott, Worcester, Worcester and other places; Allen & Thurber, Worcester, Worcester and at London; Thomas Warren, Chickopee, Springfield; Albert Eames, Springfield, Springfield; Chester W. Smith, Granby, Massachusetts, Granby, So. Hadley, and Ware; Samuel Smith, Granby, Massachusetts, Granby, So. Hadley, and Ware;

Benjamin N. Smith, deceased, Granby, So. Hadley, and Ware; Francis Clark, North Oxford, Granby, So. Hadley, and Ware; J. J. Greenough, Washington, D. C., Washington and elsewhere; J. Miller Brighton, N. J., see his patent granted June 11, 1829, saw it at Brighton, Rochester, Auburn, Canandaigua, Buffalo, Port Byron, Syracuse, New York State, and Washington, D. C.; Truman Lamson, of Bennington, Connecticut, at Bennington and [other] places; journal of Franklin institute, vol. 12, p. 408, and vol. 2, page 223; Mechanics' magazine, vol. 25, page 344, published at London, England, vol. 22, page 358; Dublin Evening Packet, published at Dublin, Ireland, May 22, 1834; same, May 18, 1833; Brevet d'Invention for 1825, vol. 11, page 42, et seq. and plate 8, and a patent granted in France to Coolidge, Uré's dictionary, supplement art., Musquet; and the defendants reserve the right to amend the above specification and add other names and public works thirty days previous to the time of trial.

Defendants will also show that said Colt, on the 19th of March, 1839, assigned to the Patent Arms M'g Co., a corporation created under the laws of the State of New Jersey, his said letters patent, dated February 25, 1836, and all his right, title, and interest in the inventions therein set forth, and all rights and benefits belonging to him as inventor thereof, and that said Patent Arms M'g Co., and their assigns, have ever since been proprietors of the same. And that, on the 24th of October, A. D. 1848, the said Colt had no right to institute the proceedings under which his patent was then reissued, nor to receive said letters patent, because he was not then the proprietor of said letters patent, or of said invention. Nor had he a right to obtain his said extension on the 8th of March, 1849.

The defendants will further show, that said extension was granted illegally, because notice of plaintiff's petition was not ordered or published according to law, and there was at that time another petition pending for the same extension, the consideration of which had been postponed from the day of to the day of then next.

And said Colt is not now, and has not been, the proprietor of said improvements or invention since his assignment.

SAMUEL COLT }
vs. }
MASS. ARMS CO. }

U. S. circuit court, Mass. district.

Defendants' amendments and additions to their notice of defence.

The defendants will show, that Edwin H. Prescott and Allen & Thurber had prior knowledge of said improvements, at Grafton, in the county of Worcester.

They further describe the title page of the Brevet d' Invention as follows: Description des machines et procédés specifics dans les brevets d'invention de perfectionnement et d'importation," published at Paris,

France; and they make the following additional references to it. Vol. 22, published in 1832, and plate 18, Jacques Phillips' patent; vol. 15, page 316 et seq., and plate 24, published 1823; also Journal of Franklin Institute, vol. 4, page 124, published August, 1829, Artemas Wheeler's patent; do., June 11, 1829, James Miller's patent; do., vol. 4, page 183, and vol. 21, page 44, 1838.

The defendants will further show, that the plaintiff's specifications and claim annexed to his letters patent, granted October 24, 1848, are different from that annexed to his letters patent granted February 25, 1836, and contain new claims; also that the extension of his letters patent was fraudulently obtained.

By their attorney,

R. A. CHAPMAN.

Also that the postponement mentioned in the first notice was from the first day of March, 1848, to the first Monday of January 7, 1850.

R. A. CHAPMAN.

SAMUEL COLT
vs.
MASS. ARMS CO.

U. S. circuit court, Mass. district, April 12, 1851.

Additional notice of names of persons who had previous knowledge of plaintiff's patented improvements.

Morgan Olmstead and A. Taylor of Auburn, Cayuga county, N. Y., saw them used at Auburn. Isaac Bennett, of Fleming, in said county, saw them used at Fleming and Auburn. Chauncey Snell, of Elmira, Steuben county, N. Y., saw them used at Elmira and Auburn.

R. A. CHAPMAN, *defendants' attorney.*

Additional notice of names of persons who had previous knowledge of plaintiff's patented improvements, in the case of Colt vs. Mass. Arms Co., May 10, 1851.

Adam Hamburgh, Summersett, Perry county, Ohio, saw it at Summersett and Thom, Ohio. Orison Blunt, of New York city, saw it at New York. Isaac D. Brady, Whittockville, Westchester county, N. Y., saw it at Whittockville and New York city. William Billinghurst, Rochester, at New York; and William H. Smith, of Rochester, saw it at Rochester and New York city.

James Evans, Riley Rogers, and Elisha Rogers, all of Utica, New York, saw it at Utica and Rochester.

R. A. CHAPMAN, *Defendants' attorney.*

SPRINGFIELD, *May* 2, 1851.

DEAR SIR: I wish to add to our notice in the case of Colt vs. Mass. Arms Co., the christian names of Allen and Thurber, viz., Ethan Allen and Charles Thurber, of Worcester, and that they saw the im-

provements at Shrewsbury, Mass. Also to add the name of Augustus Taylor, of Ira, Cayuga county, N. Y., who saw it at that place, and at Auburn, New York. Yours, respectfully,

R. A. CHAPMAN.

To B. R. CURTIS, esq.

SAMUEL COLT
vs.
MASS. ARMS CO.

United States circuit court, Massachusetts district, April 30, 1851.

Additional notice of names of persons who had previous knowledge of the plaintiff's patented improvements: Hugh McLelan, Milo Webster, J. G. Downee, John Vanderheyden, Elijah Snell, all of Auburn, Cayuga county, New York; Cherry Snell, of Elmira, Chemung county, New York; Isaac Bennett, of Stirling, Cayuga county, New York, saw the improvements used at Auburn. Garrett Helling, and James D. Helling, Dr. Sherwood, Loring Sherwood, Elisha Mattison, all of Hoosic, New York, saw them used at Hoosic. John M. Caswell, deceased, and John M. Caswell, jr., of Lansingburg, saw them used at Lansingburg.

R. A. CHAPMAN, *Defendants' attorney.*

To B. R. CURTIS, esq.,
*Plaintiff's attorney.*

SAMUEL COLT
vs.
MASS. ARMS CO.

United States circuit court, Massachusetts district.

Plaintiff is notified to produce on the trial of the said cause, the original letter or letters sent to plaintiff by the acting commissioner of patents, dated September 22, 1848, and directed to the care of Mr. Keller. R. A. CHAPMAN, *Def'ts' attorney.*

And at the same time, to wit, on the first day of July, A. D. 1851, the following agreement was filed, viz. :

Circuit court of the United States, first circuit, district of Massachusetts.

Between—
SAMUEL COLT, plaintiff,
and
THE MASSACHUSETTS ARMS COMPANY, defendants.
} In case.

It is stipulated and agreed, by and between the parties to the above entitled cause, that, if the jury should render their verdict for the plaintiff in the trial of said cause, assigned for the thirtieth day of June

inst., no damages shall be assessed by them for the plaintiff; and when judgment shall be entered for the plaintiff under such verdict, it shall be for the sum of one dollar, with costs of suit, the actual damages being reserved for disposal as herein after provided for. And it is further stipulated and agreed, that in case of such verdict for plaintiff, as herein before stipulated, and the plaintiff should thereafter commence another action, either in law or equity, for damages against the said defendants, he shall not be precluded from claiming damages for the pistols made and sold by the defendants before the date of the present action, but shall be entitled to go into an account of the arms made by the defendants from the commencement of their manufacturing, in the same manner as if no previous suit had been instituted and recovery had against them, and shall be entitled to damages upon all the arms made from the commencement of the defendants' manufacture, if he shall recover under such action.

And it is agreed that this stipulation shall be filed in this cause, with the clerk of this court, and be entered upon the record of the judgment in said cause as an addition to the pleadings therein.

Signed at Boston, this twenty-eighth day of June, A. D. eighteen hundred and fifty-one.

But this agreement shall have no other injurious effect upon the rights of the defendant than to leave the question of damages open as aforesaid, it being the object of this agreement merely to save the expense of litigating the question of damages now.

And the defendants shall further have the right, in case the verdict shall be rendered against him, to enlarge the sum rendered as damages, it being agreed that such sum shall not be conclusive on the plaintiff, but shall merely be accounted for as far as it goes in any future action.

R. A. CHAPMAN.
EDW'D N. DICKERSON,
*Counsel of plaintiff.*

Issue being joined as aforesaid, the cause after a full hearing is committed to a jury, sworn according to law to try the same, who, after hearing all matters and things concerning the same, return their verdict therein, and upon oath say:

The jury in the case of Colt vs. Mass. Arms. Co. find in the plaintiff's gun a new and novel combination to produce the effect described in his patent not found in any other fire arm prior to his invention; and the jury further find the defendants have infringed on the first three claims of the plaintiff's patent, and assess damages in the sum of one dollar, according to the agreement.

Thence said cause was continued to this present term, and now it is considered by the court that the said Samuel Colt recover of the said Massachusetts Arms Company the sum of one dollar damages, and costs of suit taxed at .

Whereupon the defendants filed the following bill of exceptions, viz:

CIRCUIT COURT OF THE UNITED STATES,
*District of Massachusetts.*

COLT
vs.
THE MASSACHUSETTS ARMS CO.

This was an action on letters patent, dated February 25, 1836, alleged to have been extended March 8, 1849, which letters, with the writ, pleadings, and notice of defence, are made part of this bill, and hereto are annexed.

On the trial of this cause the defendants offered to show by the record, a copy whereof is hereto annexed, and forms part of this bill of exceptions, the course of proceedings upon the plaintiff's application for an extension.

The record is as follows, to wit:

No. 127.

In the matter of the application of Samuel Colt for an extension of his patent for improvements in "fire arms."

In this case the patent bore date the 25th February, 1836, and consequently would expire on the 25th February, 1850.

The petition and usual fee were received January 17, 1848, and a day of hearing appointed 21st February, 1848, of which due notice was given in the newspapers.

February 21st, 1848, hearing adjourned to February 23.

February 23. The board of extension met; present, James Buchanan, secretary of state; Edmund Burke, commissioner of patents, and R. H. Gillett, solicitor of the treasury, and ordered that the further hearing of this application be postponed to March 1st, 1848, and that the memorial of the said Colt be submitted to the Secretary of War for his opinion whether or not the interests of the Government will be promoted by the extension of the patent of the said Colt at this time.

March 1st, 1848. The board met pursuant to adjournment; present, James Buchanan, secretary of state; Edmund Burke, commissioner of patents, and R. H. Gillett, solicitor of the treasury, and ordered, that the further hearing of the application be postponed to the first Monday in January, 1850.

March 8th, 1849. On the consideration of the petition of the said Samuel Colt, dated February, 1849, setting forth reasons for immediate action on his said application, and the additional testimony presented in support thereof, the undersigned now authorized to extend patents by the provisions of the act of Congress, approved 27th May, 1848. Ordered that the said patent be extended.

EDMUND BURKE,
*Commissioner of Patents.*

And thereupon the defendants prayed the court to instruct the jury

thereon that the said extension was void and invalid, for the reason that the requirements of the law had not been complied with, that the notice required by the law had not been given, that no report of an examiner had been had according to law, and that after a postponement, until the 1st day of January, A. D. 1850, the extension could not be legally granted without notice at an earlier period.

But the court rejected the evidence offered, not for the reason that the said record was not the proper mode and species of proof, and not duly authenticated, but for the reason that the facts offered to be proved were incompetent and unavailing to affect the validity of the extension, and refused said prayer, and ruled and held the same valid in law.

To which ruling and refusal the defendants then and there excepted.

And the defendants also prayed the court to instruct the jury, that if the plaintiff's act in obtaining the extension was unconscientious and immoral, the extension was void; and thereunder introduced the evidence of J. J. Greenough, as follows:

I am a mechanical engineer, and have been for some years employed as a solicitor of patents. I was employed as counsel for Mr. Wesson in obtaining his letters patent. My residence is in Washington. I was retained by Mr. Wesson and Mr. Leavitt to oppose the extension of Mr. Colt's patent. I went to the Patent office to examine the proceedings. It has been formally objected to by the board of commissioners for the extension of patents to decide upon a patent long before its expiration, on the ground that the inventor could not make up his account of profits upon it until it had nearly run out. I was retained by Wesson and Leavitt to oppose this extension about the time I made the application for Wesson's patent.

I do not recollect the date; it was a little more than a year before the patent was issued. I have not retained the dates in my mind, and have not refreshed my memory with them for a year or more. Somewhere about that time, (August, 1848,) it was as early as that, I am unable to give the exact date, I could do so if I had my books and minutes here. I think the application for the extension had not been made when Mr. Wesson spoke to me about it. I think, when he first spoke to me about it, he said he had no doubt that Mr. Colt would attempt to get an extension. I am not positive as to the reasons he gave for his opinion, and he desired me to appear for him. Mr. Wesson retained me to get his own patent; his application was made more than a year before he obtained the patent; I think it was a very long time before; his patent was never opposed, to my knowledge, before the office; the office gave me no information to that effect, but I have since seen on the record of the office letters. I made a communication to Mr. Colt on that subject. He called on me to get me to transact some business for him, which I did, telling him, at the same time, that I was employed for Mr. Wesson, and, of course, that I could do nothing that would interfere with Mr. Wesson's rights. The date I have forgotten, but it was during the pendency of Mr. Wesson's case;

it was some time before the date of the extension that I made this communication to Mr. Colt. I went to the Patent office to examine the proceedings on the extension, and I found out the continuance from the records of the office.

I went to the files of the office, where I knew these things were placed on file, and examined the records. I did not see the Commissioner or Mr. Colt; they told me nothing about it. I read of that document (the record) in the Patent office. I have no knowledge of the application of February, 1849, before the extension was granted. I knew nothing of the hearing before the Commissioner until after the extension was granted. It was but a few days after March 1st, 1848, when I learned of the postponement. It may have been two or three weeks before I saw it officially, though I think it was not so long as that.

On cross examination he said: I did not (file an opposition to the extension of Colt's patent.) I did not consider that the time had arrived to file one. I cannot tell the date when I was retained. I know it was at the time when I first commenced to take out the patent for Wesson.

Question. Was it not after the time limited for opponents to come in?

Answer. I think not; I think it was before.

*Re-examination.*

Question. You state the time had not arrived to file the opposition to Mr. Colt's extension; state why.

Mr. Dickerson. He said he had not filed any opposition.

Mr. Curtis. He said he did not come within the time fixed by the advertisement.

Answer. I recollect making that answer to the counsel for the plaintiff. I did not consider the time had arrived for making the opposition; the time had passed for the original hearing. I sent to my clients for certain information, which I required before filing the opposition before the board in the first instance; I sent them word, or told them personally, I do not remember which, that it was put off until January, 1850, and that would give them time to file the opposition.

Question. When it was put off until that time, when should you have filed it according to practice?

Answer. Within about twenty days before the hearing; never more than that.

*Cross examination resumed.*

I did see the notice, or advertisement of the Commissioner, giving notice that [at] a certain time and place the question of the extension of this patent would be taken into consideration; I was then under the retainer of the defendants as their solicitor. I did not thereupon, for the reasons stated, file an opposition for the time appointed. It is the usual practice to have two or three hearings in these cases. I do

not know that I have made any statements as to what the practice was of granting extensions, until the time had run out.

But the court refused so to rule, and ruled that there was no evidence, or offer of any evidence, on which the jury could find such extension void, and so also instructed the jury in his closing charge.

The defendants put in evidence a patent dated , granted to Cornelius Coolidge, with a translation, and a model made in conformity thereto; which patent is made part of this bill.

On the trial thereof the defendants made the following prayers for instructions:

1st. The plaintiff's counsel, in his closing argument, having contended that the plaintiff's claim and patent is for a machine, and having deduced a law or rule of infringement therefrom, the defendant prayed the court to instruct the jury that the plaintiff's claim is not of a machine; but the court did not so instruct the jury, and instructed them that the plaintiff's claim related to a machine for fire arms.

To which refusal and ruling the defendants excepted.

2d. The defendants prayed the court to instruct the jury that the plaintiff makes five claims, and that if any one, and particularly that if any one of the three which are alleged to be infringed wants novelty, the action fails; or that the jury be instructed on the consequences of such want of novelty.

But the court did not so instruct the jury, and ruled that some one separate combination must be violated to enable the plaintiff to recover.

To which refusal the defendants excepted.

3d. The defendants prayed the court to instruct the jury, that if it be shown that there had been, before the plaintiff's alleged invention, invented, publicly known, and used, and described in a foreign publication, a fire arm, wherein the rotating breech was combined with the lock by a catch, so that, by the act of lifting the hammer to cock the piece, the breech should be liberated to admit rotation and then relocked, the second claim is void for want of novelty.

The court did not so instruct the jury, and ruled that if fire arms were before known, and were in substance the same as the plaintiff's arms, the plaintiff cannot recover.

To which refusal and instructions the defendants except.

4th. The defendants further prayed the court to instruct the jury, that, according to the use of language employed in the plaintiff's patent, the expressions, "that by the operation of lifting the hammer to cock the piece the breech shall be rotated," and "that by the act of lifting the hammer the breech shall be liberated and then relocked," apply to and include, as well the case where the operation of cocking enables a spring to rotate and liberate or relock, as where the operation of cocking exists, a more direct or other agency to cause rotating, liberating, or relocking; and that, if before the plaintiff's alleged invention, there had been invented, publicly known, and used, and described as aforesaid, an arm, wherein the breech was combined with the lock, so that by the operation of cocking the lock the breech should be rotated

to the proper extent, then, whether the cocking operated so as to enable the spring to relock the breech, or so as to enable a lever or a pall, assisted by a spring, to do it, this claim is void for want of novelty.

The court did not so instruct the jury, and ruled that, if the effects and mode of operation be the same, they must be deemed the same in substance; and he also instructed the jury that, in regard to Coolidge's gun, *that* if the spring therein was wound up by hand, and if after several had been so made they were thrown aside, it was not the same as the plaintiff's.

To which ruling the defendants excepted.

The instructions above set forth were given in the handwriting of the judge, at the foot of the prayers respectively, and sent by him to the jury; but in addition thereto, and to be taken in connexion therewith, and in qualification thereof, if it does so qualify, he instructed the jury in his charge as follows:

I hasten to another consideration connected with this subject, as to the extension, in the procurement of which the defendants aver that there was some moral fraud, and that it would, therefore, vitiate a recovery here by the plaintiff. As you heard in the course of the trial, the Commissioner, in acting on this subject, acts under a law of Congress, and it is his business to conform to the law; it is his business not to make the extension until he is satisfied that the party has not been sufficiently rewarded; and when he is so satisfied it is his duty to grant the extension, making it in conformity to that law. It is not the case of a suit between A and B; it is a proceeding pending between a patentee and the Government; but, with abundant caution, the Government says in its law, that when this application is made the Commissioner shall give notice to the world that they may come in and show why it should not be extended.

In this case notice was given, and a certain time fixed for the purpose. Nobody appeared. Probably some opposition was expected from the adjourning it; the adjournment may have been made for the purpose of requiring other testimony—the testimony not having been prepared until it was ascertained whether there would be opposition—testimony as to expenditures and receipts, to see how the balance stood. Notice of the day had been given in court; any body disposed to make opposition could do so; no one chooses to go. I do not know that the Commissioner does wrong after that, whenever he has evidence that the party was not remunerated, in making an extension; it ought to be made seasonably, that the party may know whether he is to have seven years more; and I do not know that any body has a right to complain, if he does not choose to go there and make opposition at the time mentioned.

But whether he did right or wrong the extension is legal; it is valid, as regards the original patentee, and nobody has a right to complain in a moral or any other point of view, who got notice, and did not choose to go and attend to it, because he did not intend to show that Mr. Colt had made a great deal out of it at that time, or because he thought it

more liberal to let the extension take place, or that it was very likely to take place if he did oppose it, on account of the great merit of the machine. Whatever may have been the cause, he did not appear at the proper time, and the Commissioner made the extension; it is, therefore, in point of law, valid, and I see in it no evidence of fraud. If there was any fraud at all, it would be in the Commissioner rather than in any body else; I see nothing of that character. The jury cannot find fraud without the evidence.

Look a little at this in a practical point of view and as practical men. Although there may be, for instance, in a subsequent patent, two things which differ from the first patent in something beyond mechanical equivalents, form, and proportion, and though they may be improvements, and therefore not to be treated as violations of the other, yet, at the same time, it is to be considered that if there is a third thing introduced in the defendants', which is covered by the plaintiff's, patent, the party is liable for that third, although not for the other two. Therefore, it becomes important, in considering this subject throughout, that you consider these five different claims of the plaintiff. They are separate combinations. They are not five things combined into one. They are five, constituting one patent; but each is a separate combination, as you will [see] in the patent. If they were all one combination simply, and not set out as, and not in substance, different combinations, the defendants, in order to [infringe, must] violate the combination as a whole. But when there are five separate combinations, as there are in this case, the first may be violated; the second may be violated; but the third need not; because they are for separate combinations, and the language of the claim is first combining the rotating chambered breech, &c.; third, the placing the nipples, &c. They are each distinct, and not all given to form a whole as a combination. I am requested to instruct you to consider them separately, and I do so.

If the defendants use one of them, it is enough; and it is of no consequence to this result whether they are more than one or more than two, except in respect to damages. When you come to that subject, it may be of some importance to discriminate how many of them they violate, because, according to the importance of that one combination, and according to the various combinations they may encroach upon, may be the amount of damages to be recovered.

The first inquiry, after hearing what the, his, (plaintiff's,) combinations are, is whether there are any arms preceding his, which involve and unite these different improvements which he sets out he had made, and were the same in principle.

A great deal has been said here about method in the specifications. The patent is not for a method merely, but for a machine operating in that method, or mode, or form, and the patent covers it. Now, was there a former fire arm, which contained this first combination in substance, and the second in substance, and the third; or was there one which contained any one of them? If there was a machine, which contained any one of them, it would precede him on that one, but only on it.

2522.

If there is any one of the five which did not exist before him in that form, he is entitled to recover on that.

You are now prepared to take up the different fire arms which, it is said, existed before, and were similar in substance to, the plaintiff's. The only gun, according to my minutes, which is contended to have been of earlier date than Colt's invention, provided he made it in 1831, as he contends he did, is what is called the French or Coolidge gun, about which you have had a great deal of testimony; some from the person who manufactured it, and sold it pretty extensively, and was interested in the use of it. That was patented abroad about 1818, and published in 1825, so that it is early enough in date; and the only question is, whether the combination and machinery, used there to effect the object, was the same in substance or principle with that in Mr. Colt's. It is contended, on the one hand, that it was similar, and experts have been put on the stand to prove it; some of whom speak of a spring in it, for revolving the chambers, as different from the common spring which is used in fire arms, being acted upon and making a movement by that action, and by the inherent power of the spring; in other words, it was a coil spring, wound up by the hand. On the part of the plaintiff, experts say that this kind of a spring, and the mode of operating it, was different in substance from the mode of operating in Colt's, by drawing up the hammer, and in that way causing the chamber to revolve without any coil spring. On that subject I am requested to charge you, whether, in point of law, that coil spring is the same with the common spring which is often put into fire arms.

I must confess my inability to do it, unless you first find the fact for me, and that fact I submit to you; whether it is the same in substance or principle depends on whether it is the same kind of an instrument or not, and whether it acts in the same way in substance, and produces the same result in substance. If it does, you may consider it in law the same in principle. But, on the contrary, although called a spring, if it operates on a principle different from springs usually employed; if the results are not the same; if it does not act in the same manner; if it is wound up by the hand, in order to make it continue to operate, I shall tell you it was not the same in point of law. Springs may go by the same name, and not be the same in substance or principle. We talk about the main spring of a watch, but it is a very different thing from some springs; yet it is a spring. Whether it is like others in substance or not, is a question for the jury to determine, and not the court. It is a question of fact.

But I would recommend you to look at this question, as to the similarity of the French or Coolidge gun, in another view. Was that gun or rifle made so that it would operate as Colt's does; is the hand used no more in it than in Colt's? In Colt's the hand is used to draw the hammer and cock the piece, and for nothing else, so that you may go on revolving it ad infinitum; of course some one must use the hand to reload. Did the Coolidge gun operate in that way; must you or must you not in that gun use the hand to wind up the spring, as well

as to draw back the hammer, before you can turn back the cylinder; must you not use the hand then again, and wind up the spring?

But there is another consideration connected with this which presents some importance, and that is whether it was different or not. Did it succeed like this of Colt's? If it was the same in substance, if it was the same in principle, would it not have succeeded as well, and did it succeed as well?

On that you must go to the testimony of Mr. Collier. He said, that after making a small number, compared with the whole, he became satisfied, as well as all others who used the arm did, that this spring was insufficient and unnecessary in his gun, and that it was flung aside entirely, and the barrels have ever since been turned by the hand at every discharge. These are consideration to be weighed in connexion with the opinions of experts. If you believe that that spring was the same in substance as Colt's, that it operated as well as Colt's, that it was not flung aside, and still continues to operate; if you believe it could be used originally with no more employment of the hand in connexion with than in Colt's, you are at liberty, and ought probably to come to the conclusion that it contained in substance all that is in Colt's; but if you do not believe these things, if you believe the reverse was true, then this should not be considered as taking away from Mr. Colt his merits as an original inventor.

The jury returned a verdict for the plaintiff; and to the foregoing rulings and instructions the defendants except, and pray that their exceptions may be allowed.

By his attorneys, R. CHOATE & R. A. CHAPMAN.

The exceptions are allowed.

P. SPRAGUE, *Judge, &c.*

It is agreed by the counsel for the plaintiff and defendant the foregoing bill of exceptions is correct.

GEO. T. CURTIS,
*For plaintiff.*

UNITED STATES OF AMERICA,
*Massachusetts district.*

I, Isaac O. Barnes, clerk of the circuit court of the United States, for the first circuit and district of Massachusetts, do hereby certify, that the foregoing is a true copy of the record of the case, Samuel Colt vs. the Massachusetts Arms Company.

In testimony whereof I have hereunto set my hand and affixed the seal of the said circuit court, this fourteenth day of November, in the year of our Lord one thousand eight hundred and fifty-one, and in the seventy-sixth year of the independence of the United States of America.

[SEAL.]

ISAAC O. BARNES, *Clerk.*

UNITED STATES OF AMERICA, *ss.*

To Samuel Colt, of Hartford, in the district of Connecticut, manufacturer of fire arms, greeting:

You are hereby cited and admonished to be and appear before the chief justice, and associate justices, of the Supreme Court of the United States, to be holden at Washington on the first day of December next, pursuant to a writ of error filed in the circuit court of the United States, for the first circuit, wherein the Massachusetts Arms Company is plaintiff, and you are defendant in error, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected, and speedy justice should not be done to the parties in that behalf.

Witness the honorable Roger B. Taney, of the said Supreme Court of the United States, this thirtieth day of November, in the year of our Lord eighteen hundred and fifty-one.

Allowed.

P. SPRAGUE, *Judge, &c.*

ISAAC O. BARNES,
*Clerk.*

I acknowledge service of the above for the plaintiff.

GEO. T. CURTIS.